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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,323	08/01/2003	Gabor Diosi	ZAHFRI P540US	4208
20210	7590	04/29/2005	EXAMINER	
DAVIS & BUJOLD, P.L.L.C. FOURTH FLOOR 500 N. COMMERCIAL STREET MANCHESTER, NH 03101-1151			PANG, ROGER L	
			ART UNIT	PAPER NUMBER
			3681	

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/633,323

Applicant(s)

DIOSI ET AL.

Examiner

Roger L Pang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-77 is/are pending in the application.
- 4a) Of the above claim(s) 42, 43, 47, 58, 60-64 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-41, 44-46, 48-57, 59, 65-74, 76 and 77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-04, 2 & 3-05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The following action is in response to the election filed for application 1/633,323 on March 24, 2005.

Election/Restrictions

Claims 42-43, 47, 58, 60-64, and 75 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 24, 2005.

Applicant argues that all the species should be treated because the independent claim is allowable. See rejections below. Applicant's arguments have been considered, but are not persuasive.

Drawings

Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-41, 44-46, 48-57, 59, 65-74, and 76-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 39:

- 1) on line 4, the limitation of “a three planetary gear sets” should be replaced with --said three... -- in order to reference the previously introduced limitation on line 3.
- 2) on lines 8-9, applicant is claiming that the sun gear is “secured above a first shifting element and transmission housing.” This is unclear. It is suggested that applicant claim that the sun gear is secured to the housing by the first shifting element.
- 3) on line 13, applicant claims a drive shaft connected by “means of one or more of second shifting element.” It is unclear what the “of one or more” is actually claiming.
- 4) on line 17, it is unclear what “alternatively” is used for. This is not a definite claim. Also, later on, the second, third, fourth, and fifth elements are positively claimed. If these references are all being claimed to be in a specific location, an “alternate” claim of the limitations is not proper.
- 5) on line 18, see problem #3 above.
- 6) on lines 22-23, applicant claims the output shaft is connected with “one of the spiders of the second or third planetary gear set.” Applicant has only disclosed an output shaft with the output shaft connected with a spider of the third planetary gear set. Although

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this is in the alternative, applicant cannot claim an alternate embodiment that is not disclosed.

With regard to claim 40:

on line 3, the term “especially” renders all the following limitations indefinite.

With regard to claim 44, see problem #3 of claim 39.

With regard to claim 47, the limitation of “AN” should be put in parenthesis.

With regard to claim 55, see problem #3 of claim 39.

With regard to claim 57:

1) see problem #3 of claim 39.

2) on line 3, the limitation of “the planetary gear set” should be replaced with --the first planetary gear set--.

Please Note: some of these problems may also occur within the non-elected claims, and in the elected claims (but were not particularly pointed out).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 39-40, 55, 66, 68-71, and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Martyka. (“seen spatially” is being treated as seen along the axis of rotation or perpendicular to the axis of rotation (i.e. side view)) With regard to claim 39, Martyka teaches the multi-stage automatic transmission (all limitations can be found in Fig. 1), wherein seen spatially, the third 40 and fourth 42 shifting element, seen spatially, are placed radially above one another and in that the fifth 36 and the second 34 shifting element, seen spatially, are placed radially above one another. With regard to claim 40, Martyka teaches the transmission, wherein the third shifting element 40, seen spatially, is placed radially underneath the fourth shifting element 42, whereby disks of the third shifting element possess a smaller diameter than do disks of the fourth shifting element (Fig. 1). With regard to claim 55, Martyka teaches the transmission, wherein a servo apparatus of the second shifting element activates disks of the second shifting element and a servo apparatus of the fifth shifting element activates disks of the fifth shifting element axially in a direction of the first planetary gear set (Fig. 1, “a direction” is any direction). With regard to claim 66, Martyka teaches the transmission, wherein the first shifting element 32, seen spatially, is placed on a side of the third planetary gear set 30, which is remote from the second planetary gear set 28 (Fig. 1). With regard to claim 68, Martyka teaches

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the transmission, wherein an outside disk carrier of the first shifting element 32 is integrated in the transmission housing (Fig. 1). With regard to claim 69, Martyka teaches the transmission, wherein the input drive shaft 20 and the output drive shaft 24 run coaxial to one another (Fig. 1). With regard to claim 70, Martyka teaches the transmission, wherein the output drive shaft 24, which is operationally bound with the internal gear 50 of the first planetary gear set, centrally penetrates the third planetary gear set in an axial direction (Fig. 1). With regard to claim 71, Martyka teaches the transmission, wherein the output drive shaft 24, which is operationally bound with the internal gear 50 of the first planetary gear set, centrally and in an axial direction, penetrates a clutch space of the first shifting element (Fig. 1). With regard to claim 74, Martyka teaches the transmission, wherein the internal gear 50 of the first planetary gear set and the spider 76 of the third planetary gear set and the output drive shaft 24 are continually connected with one another and the spider 66 of the second planetary gear set is continually in connection with an internal gear 70 of the third planetary gear set and in that the spider 56 of the first planetary gear set is continually in contact with an internal gear 60 of the second planetary gear set.

Claims 39, 57, 72-73, and 76-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Kao '160. ("seen spatially" is being treated as seen along the axis of rotation or perpendicular to the axis of rotation (i.e. side view)). With regard to claim 39, Kao teaches the multi-stage automatic transmission (all limitations can be found in Fig. 1), wherein seen spatially, the third 58 and fourth 56 shifting element, seen spatially, are placed radially above one another and in that the fifth 50 and the second 52 shifting element, seen spatially, are placed radially above one another. With regard to claim 57, Kao teaches the transmission, wherein the third and fourth

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shifting element 56,58 is placed on a side of the first planetary gear set 40 which is remote from the second planetary gear set 30 (Fig. 1). With regard to claim 7, Kao teaches the transmission, wherein the input shaft 17 and the output shaft 19 are not coaxial, an input drive shaft axis and an output drive shaft axis are either parallel or angular with respect to one another (Fig. 1). With regard to claim 73, Kao teaches the transmission, wherein the output shaft 19, when spatially observed in a zone radially above one or more of the first, second and third planetary gear set, is operationally connected with the internal gear 24 of the first planetary gear set (Fig. 1). With regard to claim 76, Kao teaches the transmission, wherein by means of selective closure of the shifting element, at least six forward gears can be so shifted into, that for the change in gear from one gear into the next successive higher gear, or into the next successive lower gear, from the presently activated gear, in each case, only one shifting element need to be opened and an additional shifting element closed (Fig. 2). With regard to claim 77, Kao teaches the transmission, wherein the shifting elements are closed as follows: see Fig. 2.

Claims 39, 45-46, 48-51, 53-56, 59, and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Tiesler '740. ("seen spatially" is being treated as seen along the axis of rotation or perpendicular to the axis of rotation (i.e. side view)). With regard to claim 39, Tiesler teaches the multi-stage automatic transmission (all limitations can be found in Fig. 14), wherein seen spatially, the third C and fourth D shifting element, seen spatially, are placed radially above one another and in that the fifth E and the second B shifting element, seen spatially, are placed radially above one another. With regard to claim 45, Tiesler teaches the transmission, wherein disks of the fifth shifting element are placed radially beneath disks of the second shifting element (Fig. 14). With regard to claim 46, Tiesler teaches the transmission, wherein the fifth shifting

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element is placed at least predominately within a clutch space of the second shifting element, which is connected with the input drive shaft AN. With regard to claim 48, Tiesler teaches the transmission, wherein the clutch space of the second shifting element is formed by means of an output element 231 of the second shifting element, which said output element is connected with a sun gear S01 of the first planetary gear set. With regard to claim 49, Tiesler teaches the transmission, wherein a servo apparatus of the fifth shifting element is placed at least predominately within the clutch space of the second shifting element (Fig. 14). With regard to claim 50, Tiesler teaches the transmission, wherein a servo apparatus of the fifth shifting element is supported on the input drive shaft AN (Fig. 14). With regard to claim 51, Tiesler teaches the transmission, wherein a servo apparatus of the second shifting element is supported on the input shaft AN (Fig. 14). With regard to claim 53, Tiesler teaches the transmission, wherein the second shifting element possesses a dynamic pressure compensation, a pressure compensation space of which is formed by a servo apparatus of the second shifting element and a clutch cylinder of the fifth shifting element (Fig. 14). With regard to claim 54, Tiesler teaches the transmission, wherein the pressure compensation space of the second shifting element is formed by a piston of the servo apparatus of the second shifting element and an outside disk carrier of the fifth shifting element (Fig. 14). With regard to claim 55, Tiesler teaches the transmission, wherein a servo apparatus of the second shifting element activates disks of the second shifting element and a servo apparatus of the fifth shifting element activates disks of the fifth shifting element axially in a direction of the first planetary gear set. With regard to claim 56, Tiesler teaches the transmission, wherein an output element of the second shifting element at least partially overlaps disks of the fifth shifting element radially in an axial direction (Fig. 14). With

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regard to claim 59, Tiesler teaches the transmission, wherein the second and fifth shifting element are placed on a side of the first planetary gear set which is remote from the second planetary gear set (Fig. 14). With regard to claim 65, Tiesler teaches the transmission, wherein the second and the fifth shifting element border directly and axially on the first planetary gear set on that side thereof which is remote from the second planetary gear set (Fig. 14).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41, 44, and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martyka as applied to claims 39 and 66 above, and further in view of Neumann '895. With regard to claim 41, Martyka teaches the transmission, wherein the third shifting element 42, when seen spatially, is at least placed underneath the fourth shifting element 42, said elements each having servo apparatus (Col. 2). Martyka lacks the specific teaching of the locations of

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each servo apparatus. Neumann teaches two elements (both brakes like the third and fourth elements of Martyka), which have servos 130 and 132 (third and fourth, respectively), wherein the third servo is placed predominately underneath the fourth servo (Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Martyka to employ the radial servo arrangement in view of Neumann in order to save on lateral transmission housing space. With regard to claim 44, Neumann teaches the transmission, (see rejection of claim 41 above) wherein the servos activate the disks in the direction of the first planetary gear set (both activate in the same direction; Fig. 1, Martyka). With regard to claim 67, Neumann teaches the transmission, (see rejection of claim 41 above) wherein the servos are integrated into one of the transmission housing (46 Martyka; Fig. 1 Neumann).

Claims 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martyka as applied to claim 39 above, and further in view of Michioka '088. With regard to claims 50 and 51, Martyka teaches second and fifth shifting elements each having servo apparatus (Col. 2), but lack the specific teaching of each apparatus being supported on the input shaft. Michioka teaches a servo apparatus 24 connecting an input shaft 1 with an element 5c, wherein said apparatus is supported on said input shaft (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Michioka to employ a servo apparatus supported on the input shaft in further view of Michioka in order to save on space within the transmission housing and utilize an existing part for rotational support.

Allowable Subject Matter

Claim 52 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

FACSIMILE TRANSMISSION

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is (703) 305-3597. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check.

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Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____ (Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roger L Pang whose telephone number is 571-272-7096. The examiner can normally be reached on 5:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Pang', with a stylized flourish extending to the right.

Roger L Pang
Primary Examiner
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April 28, 2005